

REMARKS

The Office Action mailed September 10, 2004 has been reviewed and carefully considered. Claims 1-20 remain pending in this case, of which Claim 1 is the independent claim. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claim 5 has been amended to correct a grammatical error. No new matter has been added by this amendment.

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Regarding Claim 1, the Examiner contends there is no antecedent basis for the limitation "the data requested by at least one user". Applicants respectfully traverse this rejection. Applicants direct the Examiner to lines 3-4 of Page 12 wherein Claim 1 recites "a server means for providing data... to at least one user". Applicants respectfully submit this portion of Claim 1 provides antecedent basis for "the data requested by at least one user". Further regarding Claim 1, the Examiner contends there is no antecedent basis for "the server". Accordingly, Applicants have amended Claim 1 to recite "the server means" for which antecedent basis is provided in line 2 – "a server means".

Claim 3 stands rejected as the Examiner is unclear as to that which is referred to by "a remainder of the exchange means". Applicants accordingly amend Claim 3 herein to recite, in part, "the base station is a first portion of the exchange means which is remote from a second portion of the exchange means."

Claim 8 stands rejected as the Examiner contends there is no antecedent basis for "the exchange" in line 2. Applicants have amended Claim 8 herein to recite, in

part, "the exchange means" for which antecedent basis is provided in independent Claim 1.

Claims 15 and 16 stand rejected as the Examiner contends there is no antecedent basis for "the VOD system" in line 2. Applicants have amended Claims 15 and 16 herein to recite, in part, "the radio VOD" for which antecedent basis is provided in the preamble of independent Claim 1.

No new matter has been added by these amendments. Applicants respectfully submit Claims 1-20 now more particularly point out and distinctly claim the subject matter Applicants regard as the invention. Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Nishio et al. U.S. Patent No. 5,557,317 (hereinafter "Nishio") in view of Robbins et al. U.S. Patent No. 5,784,095 (hereinafter "Robbins") and further in view of Jackson U.S. Patent No. 6,516,466 (hereinafter "Jackson"). Applicants respectfully traverse this rejection.

Applicants respectfully note that it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to

combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note *In Re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Applicants' invention, as exemplified by independent Claim 1, discloses a radio VOD system including a server, a server manager, an exchange, and a mobile terminal, wherein video data and audio data are transmitted separately at baseband. The radio VOD system, as shown in FIG. 1 provides separate data from separate audio and video servers (10 and 20) to an exchange 60, which may include a base station 70, which separately wirelessly transmits the data to the mobile terminal 80. As shown in FIG. 2 and clearly described in the Specification at Page 8, lines 18-22 and Page 9, lines 1-11, the present invention improves upon the prior art in that audio and video information is wirelessly transmitted and received separately at baseband according to a user's request.

Nishio, as read by applicant, discloses a VOD system for providing VOD over a conventional network employing fiber optic cable, **not a wireless network** for transmission. See Nishio, Col. 2, lines 44-51, Col. 3, lines 24-32, and Col. 4, lines 3-7 and 12-14. The Examiner concedes on Page 3 of the current Office Action Nishio does not disclose providing separately a video signal and an audio signal at baseband for separate wireless transmission of the requested data. The Examiner further concedes on Page 4 of the current Office Action Nishio does not disclose the terminal means is

mobile. As Nishio describes in detail the network required to support this VOD system in the Detailed Description and FIG. 1 and does not disclose separate wireless transmission of audio and video data, it is not reasonable to assume one of ordinary skill in the art would attempt to modify the system of Nishio in the manner which the Examiner suggests.

Robbins, as read by applicant, discloses a set top terminal which uses a subscriber's television as the preferred graphical interface to display program information to a user. Applicants respectfully submit Robbins fails to disclose "a server means for providing data comprising a video file and an associated audio file" as recited in independent Claim 1. The system of Robbins merely provides for two sources of information -- one for in-band data and one for out-of-band data. Out-of-band data "originates with the CATV operator". (Robbins, Col. 4, lines 25-26) In-band data is "transmitted to the uplink from a plurality of originating sources and combined at the uplink". (Robbins, Col. 3, lines 39-41) Thus, Robbins describes a system in which associated information does not originate from the same source, as shown in Applicants' Claim 1. Further, the system of Robbins combines data for transmission, contrary to the "separate wireless transmission" of Applicants' Claim 1.

Jackson, as read by Applicants, discloses a portable digital entertainment system for distribution of songs or video games. As neither Nishio nor Robbins provide the features cited in independent Claim 1, specifically failing to disclose separate wireless transmission of a video and an associated audio file at baseband, it would not have been obvious to one of ordinary skill in the art to combine the teachings of Jackson with Nishio and Robbins. There is no indication, teaching, or suggestion in any of the cited

references which suggests the need for the improvements required to achieve the present invention. Applicants respectfully submit the Examiner has failed to present a *prima facie* case of obviousness. Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of patentable Claim 1.

A review of the art of record has failed to reveal anything that, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as reference against the independent claim herein. This claim is therefore believed patentable over the art of record.

Moreover, Applicants respectfully submit that there would have been no motivation for one of ordinary skill to attempt to such a modification, as indicated in the Office Action, of Nishio using Robbins and Jackson without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Rouffet*, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998), and no motivation has been provided by the Office Action to show reasons that the skilled artisan, confronted with the same problems as the inventor would select the elements from the cited prior art references for combination in the manner claimed, see *Id.*

Dependent Claims 2-20 are dependent from independent Claim 1 discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

Therefore Applicant respectfully requests that the Examiner withdraw the

above-stated rejections of the claims.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,



Date: December 9, 2004

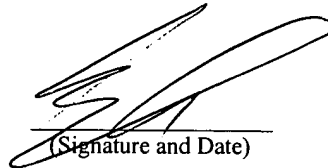
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